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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,755	06/04/2001	Maurice Clarence Kemp	MORN-0010 (108347.00021)	2361

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EXAMINER
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CHOI, FRANK I

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/27/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/873,755

Applicant(s)

KEMP ET AL.

Examiner

Frank I Choi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-59,65-96 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed processes using sulfuric acid and calcium hydroxide, calcium carbonate and/or calcium sulfate to prepare "AGIIS" and, does not reasonably provide enablement for "AGIIS" where the above components and processes are not set forth. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Applicant claims a combination of phosphate salts and an acidic sparingly soluble Group IIA complex. Applicant further indicates that normally mineral acids of low pH, such as HCl, are irritating to the skin. Applicant further indicates that the AGIIS of the invention having the same normality as saturated calcium sulfate in sulfuric acid but does not char sucrose as readily, has low volatility at room temperature and pressure, and is less corrosive to human skin. Nevertheless, an embodiment of the AGIIS contains saturated calcium and sulfate. As such, it

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appears that the comparison product contains the same components but acts differently.

However, relatively few examples of components are disclosed by the Specification and relatively few methods of preparing the AGIIS using a few of said components are disclosed. As such, it appears that the process by which the AGIIS is made is critical obtaining the results as indicated above. Further, since relatively few components are disclosed, it appears that one of ordinary skill in the art would be required to do undue experimentation in order to determine which components other than the components disclosed could be used in combination with each other or with the disclosed components and processes of preparation to arrive the AGIIS solution have said properties.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

Applicant argues that the Specification discloses how AGIIS may be formed, however, the written description requirement is separate from the enablement requirement. As indicated above, the claims are not limited to the specified processes set forth in the Specification and the Specification indicates that similar products act differently. Therefore, a claim which broadly claims AGIIS are not fully enabled by the Specification. The caselaw cited by Applicant not applicable herein. Applicant is not being required to specifically exclude possible inoperative conditions or ineffective reactant proportions. However, Applicant is required to provide sufficient enablement commensurate in scope with the claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 60-62,64 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schwank (US Pat. 5,087,467).

Schwank expressly discloses produce which has been immersed in an aqueous solution having a pH of less than 2, containing salts of phosphoric acid and sulfuric acid falling within the scope of applicant's claims (Claims 1,2,4,10).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same exact ingredients/components as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). See also *In re May*, 197 USPQ 601, 607 (CCPA 1978).

Examiner had duly considered Applicant's arguments but deems them unpersuasive.

Applicant argues intended use and lack of rinsing. However, in an inherency rejection Applicant must show that the additional step of rinsing makes the product different. The mere fact that the produce is rinsed does not appear sufficient to show that the product expressly disclosed by the prior art is outside of the scope of the claimed invention. Examiner reminds Applicant the *Graham v. John Deere* factors are not applicable in a 102/103 inherency-based rejection.

Claims 60-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwank (US Pat. 5,087,467) in view of Roden et al. (US Pat. 6,375,976).

Schwank discloses produce which has been immersed in an aqueous solution having a pH of less than 2, containing salts of phosphoric acid and inorganic acids, such as, hydrochloric, phosphoric and sulfuric acid (Claims 1,2,4,10).

Roden et al. discloses that the combination of organic GRAS acids, having a dissociation constant of from about  $10^{-1}$  to  $10^{-5}$ , having a chelating capability of a least twice of the first and second GRAS acids, such as ascorbic, citric, lactic, malic and tartaric, with said first GRAS acid which is an inorganic acid, such as hydrochloric acid, which dissociates nearly to completion in water and with said second GRAS acid which is an inorganic acid less strong than the first GRAS acid and having a dissociation constant of less than about  $10^{-1}$ , such as phosphoric acid, wherein the composition has antimicrobial activity (See entire reference, especially claims).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose a prepared nutriment comprising nutriment material and a solution or suspension having a pH of less than about 2, mineral acid and salt of phosphoric acid, and one or more of lactic, acetic, propionic, oxalic, peracetic, sorbic, benzoic, butyric, glycolic, formic and monoperphthalic. However, the prior art amply suggests the same as solutions for application to food substances containing acids and salts of phosphoric acid are known in the art. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation of producing a composition which is effecting in both disinfecting and reducing discoloration of food products.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Examiner had duly considered Applicant's arguments but deems them unpersuasive.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Further, the fact that produce may be rinsed or that a sample had a rubbery texture does not teach away from the claimed invention, as other samples were taught which had an acceptable texture and were not rinsed (Schwank, Example 3).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Roden specifically discloses that the products are safe for human ingestion and are used to treat meats, fruits and vegetables (Abstract, pg. 14). Therefore, contrary to Applicant's arguments, the prior art does teach or suggests that the products are edible and taste acceptable after treatment.

Claims 1,2,4-15,17-38,40-79,81-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwank (US Pat. 5,087,467) in view of Roden et al. (US Pat. 6,375,976) and Wurzburger et al. (US Pat. 6,331,514).

Schwank discloses produce which has been immersed in an aqueous solution having a pH of less than 2, containing salts of phosphoric acid and inorganic acids, such as, hydrochloric, phosphoric and sulfuric acid (Claims 1,2,4,10).

Roden et al. disclose that the combination of organic GRAS acids, having a dissociation constant of from about  $10^{-1}$  to  $10^{-5}$ , having a chelating capability of a least twice of the first and second GRAS acids, such as ascorbic, citric, lactic, malic and tartaric, with said first GRAS acid which is an inorganic acid, such as hydrochloric acid, which dissociates nearly to completion in water and with said second GRAS acid which is an inorganic acid less strong than the first GRAS acid and having a dissociation constant of less than about  $10^{-1}$ , such as phosphoric acid, wherein the composition has antimicrobial activity (See entire reference, especially claims).

Wurzburger et al. disclose the preparation of a disinfecting solution by combining a metal hydroxide or metal oxide, such as calcium, with an acid, such as sulfuric acid, and filtering out any precipitants, which resultant composition is effective in disinfecting meat, vegetables and fruit (See entire document).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose compositions, nutriment and methods of reducing biological contaminants with combination of AGIIS and salt of phosphoric acid having a pH of less than 2. However, the prior art amply suggests the same as solutions for application to food substances containing acids and salts of phosphoric acid are known in the art. As such, it would have been



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well within the skill of and one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation of producing a composition which is effecting in both disinfecting and reducing discoloration of food products.

Examiner had duly considered Applicant's arguments but deems them unpersuasive for the same reasons as above.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

#### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Thurman Page, can be reached on (703) 308-2927. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (703) 308-1235 and (703) 308-0198, respectively.

FIC

August 25, 2003



**S. MARK CLARDY**  
**PATENT EXAMINER**  
**GROUP 120**  
1616